

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patentee: Stephen Almeida
Title: Multiple Pulse Photo-Epilator
Serial No.: 09/173,422
Filing Date: October 15, 1998
Patent No.: 6,228,074
Issue Date: May 8, 2001
Date: October 12, 2012

PETITION FOR RECONSIDERATION UNDER 37 C.F.R. § 1.181

Mail Stop PETITION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is a petition under 37 C.F.R. § 1.181 to invoke the supervisory authority of the Director. Petitioner seeks reconsideration of Examiner's Decision on Petition, dated August 13, 2012, on Patentee's Petition to accept the delayed payment of maintenance fees due on the above-identified patent under 37 C.F.R. § 1.378(b), on an expedited basis, whereby the patent will not be considered as having expired. The request for reconsideration is filed on behalf of Stephen Almeida, who is the inventor of U.S. Patent No. 6,228,074, the above-identified patent (the Petition Patent).

Patent No. 6,228,074 was issued on May 8, 2001. The first maintenance fee was paid in accordance with the provisions of 37 C.F.R. §1.362(e)(1). The second maintenance fee could have been paid with the surcharge set forth in 37 C.F.R. 1.362(e)(3) as late as June 3, 2009.

Since the second maintenance fee was not paid, Patent No. 6,228,074 expired after midnight on June 8, 2009.

DECISION ON PETITION

The Patent Office held that the showing of record was inadequate to establish unavoidable delay. The Patent Office stated that the Petition was lacking in that the Petitioner had not identified the error which was the cause of the delay at issue, had not shown that there was in place a business routine for performing the clerical function that could reasonably be relied upon to avoid errors in its performance, and had not provided evidence of checks on the described work which were used to assure proper execution of assigned tasks.

The Patent Office dismissed Petitioner's petition and stated that the Petitioner should have supplied the source of the error which led to the delay and/or its cause and what steps were in place to avoid the error which led to the delay. In particular, the Patent Office stated that Petitioner should have shown that there was a system in place for tracking and paying the maintenance fee. The Examiner also contended that the Petitioner's process for transferring files was unreliable because a second patent, U.S. Patent No. 6,585,986, also was allowed to go abandoned for failure to pay the requisite maintenance fee.

SHOWING OF UNAVOIDABLE DELAY

A showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be timely paid and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the expiration of the patent has been set forth in detail in the attached declarations in support of this petition. Petitioner seeks the supervisory authority of the Director, as it respectfully submits that the Examiner's decision

presents exceptional circumstances, as it is contrary to the record clearly established by the Petitioner and the law regarding unavoidable delay.

The Examiner in his decision stated that in order to support a showing of unavoidable delay the Petitioner must make a showing of the following:

“An adequate showing requires:

(A) Statements by all persons with direct knowledge of the circumstances surrounding the delay, setting forth the facts as they know them.

(B) Petitioner must supply a thorough explanation of the docketing and call-up system in use and must identify the type of records kept and the person responsible for the maintenance of the system. This showing must include copies of mail ledgers, docket sheets, filewrappers and such other records as may exist which would substantiate an error in docketing, and include an indication as to why the system failed to provide adequate notice that a reply was due.

(C) Petitioner must supply information regarding the training provided to the personnel responsible for the docketing error, degree of supervision of their work, examples of other work functions carried out, and checks on the described work which were used to assure proper execution of assigned tasks.” (“August Petition Decision”, Attachment A hereto, Pg. 7),

Petitioner respectfully submits that it has met this burden.

In particular, Petitioner discovered during the course of its investigation the source of clerical error that led to the unavoidable delay and the reasonable steps that were in place to avoid the expiration or abandonment of a patent or application due to such clerical error. As the previously submitted declaration of Keith Schultz (“Schultz Declaration”, Attachment B hereto) established, Mr. Schultz failed to instruct a recognized docketing company (CPI), shared by both the former firm and present firm, to transfer the electronic docketing information of the subject expired patent. This failure to transfer the relevant docketing information without question caused the subject patent to expire for failure to pay a maintenance fee. The Examiner acknowledges, within his decision, this finding and the declaration of Keith Schultz as follows:

"The declaration of Keith Schultz, Director of Information Services for Brown Rudnick, filed on January 19, 2012, states, in pertinent part, that: 11. Pursuant to this request we made arrangements to have the Client's physical files transferred. We further made arrangements, in coordination with CPI, to transfer the Client's electronic docket entries on the CPI system to Seyfarth. The transfer of the electronic docket entries apparently only affected a transfer of selected Client files concerning matters 7 and 9 and not all Client matters, as the Client had instructed. During the course of Brown Rudnick's investigation, regarding the circumstances giving rise to the expiration of the Petition Patent, it was determined that the selected electronic files attempted to be transferred, matters 7 and 9, concerned non-patent matters for the Client, which contained no docket information; 12. Despite a diligent investigation, I am unsure why a request for the electronic transfer of docketing information for only selected files was sent to CPI, for the Client..." ("August Petition Decision", Pg. 8) (emphasis added).

Despite this clear explanation as to the source of the clerical error causing the Petition Patent to go abandoned, the Examiner somehow finds this to be insufficient and suggests, contrary to the facts found in the clear language of the Shultz declaration, the following:

"Petitioner has not explained whether Schultz or another person was responsible for actually making the determination of what information to send, or not to send, to CPI, and ultimately Seyfarth Shaw, or why this decision was made." ("August Petition Decision", Pg. 9).

Quite simply, the record clearly establishes by the plain language of the Schultz declaration that Schultz was in charge of the transfer of the files, both electronic and physical, between the former firm and the Petitioner's new firm and that he inadvertently failed to do as the client instructed, as he acknowledges in declaring as follows: "The transfer of the electronic docket entries apparently only affected a transfer of selected Client files concerning matters 7 and 9 and not all Client matters, as the Client had instructed." ("Shultz Declaration", ¶ 11).

This clerical error by Shultz compounded and apparently caused other failures by Brown Rudnick in the transfer of the files between the two firms. As the Petitioner established, with relevant declarations from all parties having direct knowledge, that the parties had other failsafe

procedures to account for clerical error in the transfer of files. Notably, the physical files created a counter-check against the above failure to transfer electronic docketing information, as stated in the declaration of June Kaps (“Kaps Declaration”, Attachment C hereto). Additionally, when a file transfer failure occurred, as it apparently did in this matter, to transfer both the physical file and its corresponding electronic docketing information, notices sent from the USPTO were forwarded in accordance with standard policy at Brown Rudnick, as noted in the declaration of Mark Leonardo (“Leonardo Declaration”, Attachment D hereto). This additional stopgap measure ensured that in the absence of proper file transfer of physical and electronic files, lost or misplaced files, notices from the USPTO would provide a final failsafe measure.

The Examiner in his decision fails to acknowledge all components of the file transfer protocol, which was clearly established within the record, as he suggests the following:

Obviously, if the purpose of the business routine was to transfer files from Brown Rudnick to Seyfarth Shaw, and Brown Rudnick mistakenly told CPI not send the required information concerning this patent to Seyfarth Shaw, the business routine cannot be relied upon to serve its intended purpose, and the delay cannot be considered unavoidable (August Petition Decision, Pg. 9).

The Examiner defying the facts of this matter, which establishes a transfer protocol having electronic file transfer, physical file transfer, physical check of files against electronic docket entries, and notices from the USPTO, relies on the expiration of a U.S. Patent No. 6,585,986 (‘986 patent), a patent within the family of the Petition Patent to suggest that the transfer method could not be relied upon.

The Examiner’s reliance is misplaced and contrary to the record, as the detection of the expiration of the ‘986 patent indicates that the process was reliable because the system in fact detected the expiration of the ‘986 patent; as Brown Rudnick forwarded the USPTO notice

according to their standard business practice. Based upon the receipt of the USPTO notice from Brown Rudnick, Petitioner's counsel was able to revive the '986 patent by the payment of the required fees.

The Petitioner, mindful of the Examiner's previous request for information, provided a thorough explanation of the experience and training of the parties involved; the docketing systems used by both parties and evidence that a reliable system was in place for transferring this data. Petitioner has previously submitted Declarations from Stephen Almeida, the named inventor of the patent; June Kaps, former employee at Brown Rudnick Israel LLP and docket administrator at Seyfarth Shaw, LLP; Edwin Colon, Records Supervisor for Seyfarth Shaw; John Serio, formerly of Brown Rudnick and presently a partner at Seyfarth Shaw; Mark S. Leonardo, who at all times relevant was the Chair of the Intellectual Property Department at Brown Rudnick; and Keith Schultz, Director of Information Services for Brown Rudnick. These Declarations, when taken together, clearly establish that Brown Rudnick, because of an inadvertent clerical error, unavoidably failed to transfer at least the requested electronic docketing information to Seyfarth Shaw, which has a reliable docket system to ensure timely payment of maintenance fees.

The inadvertent docketing information transfer error by Brown Rudnick and its apparent corresponding failure to transfer relevant physical files, caused the docket records at Seyfarth Shaw not to reflect the maintenance fees that were due for the Petition Patent. As a result of the clerical error that caused a docketing information transfer error, docketing information was not received by Seyfarth Shaw causing the matter of the Petition Patent not to be entered in Seyfarth Shaw's docketing system and the correspondence address not to be updated at the Patent Office.

Petitioner contends that the record in the Petition to Revive is complete and satisfies the requirements 37 C.F.R. § 1.378(b); and that the Examiner's decision is presents exceptional circumstances, as it is contrary to the law and the facts of the established record. Under 37 C.F.R. § 1.181, Petitioner invokes the supervisory authority of the Director to determine that the facts of this matter meet the requirements of an unavoidable delay and therefore find in favor of the Petitioner.

Respectfully Submitted,

October 12, 2012

Dated:

/John C. Serio/

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